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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

LEE, PHILIP C

ART UNIT PAPER NUMBER

2154

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/922,421	Applicant(s) GOMES ET AL.	
	Examiner Philip C. Lee	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. This action is responsive to the amendment and remarks filed on August 05, 2005.
2. Claims 1-12 and 14-16 are presented for examination and claim 13 is cancelled.
3. The text of those sections of Title 35, U.S. code not included in this office action can be found in a prior office action.

Claim Rejections – 35 USC 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 6-7, 9-12 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singhal, U.S. Patent 6,256,666 (hereinafter Singhal) in view of "Official Notice" and Keeney et al, U.S. Patent 6,748,471 (hereinafter Keeney).
6. Singhal and Keeney were cited in the last office action.

7. As per claim 1, Singhal taught the invention substantially as claimed for applying information to an appliance via both a mobile device and a computer system, the information being stored in a sub-computer system, the method comprising the following steps:

designating the information to be processed and the appliance to which the information is to be applied as instructions in the mobile device (col. 5, lines 8-16, 40-49);

transmitting the instructions from the mobile device to the computer system via a communication network (col. 5, lines 14-16; col. 6, lines 3-5);

transmitting the information from the sub-computer system to the computer system via the communication network (col. 6, lines 43-45), if the instructions from the mobile device are present in the computer system (col. 6, lines 34-36);

transmitting the formatted information from the computer system to the appliance via the communication network (col. 7, lines 49-54); and

applying the formatted information to the appliance for processing according to the instructions (col. 7, lines 49-54).

8. Singhal did not specifically teach that the communication network is the Internet.

“Official Notice” is taken for the concept of the Internet as the communication network is known and accepted in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the Internet because by doing so it would increase mobility of Singhal’s system by allowing a remote user to exchange data via the internet.

9. Singhal did not teach polling the computer system and converting the information to formatted suitable for the appliance. Keeney taught a similar system comprising:

polling the computer system by the sub-computer system via both a second communication network and a firewall (col. 12, lines 18-41); and converting the information to formatted information suitable for the appliance according to the instructions (col. 9, lines 56-60).

10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Singhal in view of “Official Notice” and Keeney because Keeney’s system of polling would increase security of Singhal’s system by enabling a device (e.g. sub-computer) to poll the server (e.g. computer system) without the server to initiate contact to avoid the potential breach of firewall security in a local network environment (col. 6, lines 13-25).

11. As per claim 11, Singhal taught the invention as claimed which allows a user of a user of a mobile device to apply information stored in a sub-computer system to an appliance designated by the mobile device, wherein the sub-computer system and the appliance are connected to the computer system, the computer system comprising:

a first interface for receiving instructions from the mobile device via a communication network (col. 5, lines 14-16; col. 6, lines 3-5), wherein the instructions designate the information to be processed and the appliance to which the information is to be applied (col. 5, lines 8-16, 40-49);

a second interface for receiving the information sent from the sub-computer system according to the instructions (col. 6, lines 43-45); and

a third interface for sending the information to the appliance via the communication network (col. 7, lines 49-54).

12. Singhal did not specifically teach that the communication network is the Internet.

“Official Notice” is taken for the concept of the Internet as the communication network is known and accepted in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the Internet because by doing so it would increase mobility of Singhal’s system by allowing a remote user to exchange data via the internet.

13. Singhal did not teach receiving polling signal. Keeney taught a similar system comprising:

polling the computer system by the sub-computer system via both a second communication network and a firewall (col. 12, lines 18-41).

14. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Singhal in view of “Official Notice” and Keeney because Keeney’s system of polling would increase security of Singhal’s system by enabling a device (e.g. sub-computer) to poll the server (e.g. computer system) without the server to initiate contact to avoid the potential breach of firewall security in a local network environment (col. 6, lines 13-25).

15. Although, Singhal and Keeney did not specifically teach a server computer for performing the functions of processing, receiving and sending the information, however, Singhal taught the computer system connected to the first interface (col. 5, lines 14-16; col. 6, lines 3-5), the second interface (col. 6, lines 43-45) and the third interface (col. 7, lines 49-54), for processing and storing the instructions, for receiving the information (col. 5, lines 17-23), and further for sending the information to the appliance for processing (col. 7, lines 49-54).

16. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a server computer system for performing the functions of processing, receiving and sending the information because by doing so would improve the efficiency of their system by sharing some of the processes in the computer system with a server computer.

17. As per claims 2 and 12, Singhal in view of "Official Notice" and Keeney taught the invention substantially as claimed in claims 1 and 11 above. Keeney further taught that the step of transmitting the formatted information from the computer system to the appliance comprises:

polling the computer system by an appliance server via both the communication network and a further firewall (col. 3, lines 48-63);

transmitting the formatted information from the computer system to the appliance server via both the communication network and the further firewall due to polling by the appliance server, if the formatted information is present in the computer system (col. 3, lines 40-45; col. 8, lines 50-63); and

transmitting the formatted information from the appliance server to the appliance according to the instructions (col. 8, lines 50-63).

18. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Singhal in view of "Official Notice" and Keeney because Keeney's system of polling would increase security of Singhal's system by enabling a device (e.g. sub-computer) to poll the server (e.g. computer system) without the server to initiate contact to avoid the potential breach of firewall security in a local network environment (col. 6, lines 13-25).

19. As per claim 3, Singhal in view of "Official Notice" and Keeney taught the invention substantially as claimed in claim 1 above. Keeney further taught that the step of formatting the information to the formatted information is executed from an appliance server (col. 14, lines 28-30).

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Singhal in view of "Official Notice" and Keeney because Keeney's system of formatting information as the appliance server would increase the efficiency of Singhal's system by off-loading the process from the computer system.

21. As per claim 4, Singhal in view of "Official Notice" and Keeney taught the invention as claimed in claim 1 above. Keeney further taught that a plurality of appliances is connected to the

computer system (col. 1, lines 15-20; col. 7, lines 2-3), the mobile device further designating the appliance among said plurality of appliances in the instructions (col. 10, lines 39-45).

22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Singhal in view of "Official Notice" and Keeney because Keeney's system of designating the appliance in the instruction would increase the mobility of Singhal's system by allowing a mobile user to be able to print from a machine on one local area network to a printer located on a different local area network (col. 2, lines 32-36).

23. As per claim 6, Singhal in view of "Official Notice" and Keeney taught the invention substantially as claimed in claim 4 above. Singhal further taught that the mobile device designates the appliance by specifying the appliance identity in the instructions (col. 5, lines 40-51).

24. As per claims 7 and 14, Singhal in view of "Official Notice" and Keeney taught the invention substantially as claimed in claims 1 and 11 above. Singhal in view of "Official Notice" and Keeney did not specifically teach including the location of the information into the instruction, however Singhal taught retrieving the information according to the message ID in the instruction (col. 6, lines 43-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to including the location of the information in the instruction because by doing so would improve the retrieval time of the information.

Art Unit: 2154

25. As per claims 9 and 15-16, Singhal in view of "Official Notice" and Keeney taught the invention substantially as claimed in claims 1 and 11 above. Keeney further taught wherein the appliance is a printer, and the computer system converts the information to a print job in a format suitable for printing (col. 9, lines 56-60).

26. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Singhal in view of "Official Notice" and Keeney because Keeney's system of including a printer would increase the field of use in Singhal's system.

27. As per claim 10, Singhal in view of "Official Notice" and Keeney taught the invention substantially as claimed in claim 9 above. Keeney further taught wherein the computer system converts the information to a PDL format for printing (col. 13, lines 54-67; col. 14, lines 11-12).

28. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Singhal in view of "Official Notice" and Keeney because Keeney's system converting the information to a PDL format would increase functionality of Singhal's system by allowing printers that accept PDL format to process the information for printing.

29. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singhal in view of "Official Notice" and Keeney as applied in claim 4 above, and further in view of Lomas et al, U.S. Patent 6,424,424 (hereinafter Lomas).

30. Lomas was cited in the last office action.

31. As per claim 5, Singhal in view of "Official Notice" and Keeney taught the invention substantially as claimed in claim 4 above. Singhal in view of "Official Notice" and Keeney did not teach that the appliances registering in the computer system. Lomas taught wherein said plurality of appliances is registered in the computer system (col. 3, lines 31-35; col. 4, lines 45-47).

32. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Singhal in view of "Official Notice", Keeney and Lomas because Lomas's method of registering printers would increase efficiency by allowing list of network printers for use by a client (col. 3, lines 30-35).

33. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singhal in view of "Official Notice" and Keeney as applied in claim 1 above, and further in view of Carini et al, U.S. Patent 6,636,873 (hereinafter Carini).

34. Carini was cited in the last office action.

35. As per claim 8, Singhal in view of "Official Notice" and Keeney taught the invention substantially as claimed in claim 1 above. Although Singhal in view of "Official Notice" and

Keeney taught that the mobile device communicates with a gateway by using standard telecommunication protocols (see Keeney, 10, 30, fig. 1), they did not specifically detailing that the gateway converts the instructions to a suitable format. Carini taught that the gateway converts the instructions to a format which the computer system understands (col. 3, lines 16-24).

36. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Singhal in view of "Official Notice", Keeney and Carini because Carini's teaching of the gateway converting the instructions to a format that the computer system understands would increase the functionality of Singhal's and Keeney's system by allowing the gateway acts as a bridge to enable communication between mobile device and wired computer (col. 3, lines 24-30).

37. Applicant's arguments with respect to claims 1-12 and 14-16, filed 8/5/05, have been fully considered but are not deemed to be persuasive and are moot in view of new ground of rejection.

38. In the remark applicant argued that

- (1) Singhal did not teach the mobile device and the mobile access gateway communicate via the Internet.
- (2) Singhal did not teach the mobile access gateway and the email server communicate via the Internet.

(3) the skilled person would not combine the teachings of Keeney with Singhal.

39. In response to points (1) and (2), Singhal taught a mobile device and an email server in communication with a mobile access gateway (fig. 3; col. 4, lines 12-40). Singhal further taught wherein the physical locations of the components shown in figure 3 may differ in alternative embodiments. For example, the Mobile Access Gateway 320 need not execute on the same machine as the e-mail server 300; it may execute on the user's laptop 305 or desktop machine 306 (col. 4, lines 41-48). According to figure 3, if the Mobile Access Gateway is executed on the user's laptop 305 or desktop machine 306, then the mobile devices (335-337, fig. 3) and the e-mail server (300, fig. 3) must communicate via network (301, fig. 3). Singhal did not specifically teach that the communication network is the Internet. "Official Notice" is taken for the concept of the Internet as the communication network is known and accepted in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the Internet because by doing so it would increase mobility of Singhal's system by allowing a remote user to exchange data via the internet.

40. In response to point (3), the combination of Singhal in view of "Official Notice" taught the invention in the field of open network. As stated in the applicant's remark on page 8, paragraph 2, it would make sense to use a firewall and a polling method in an open network. Accordingly, one of ordinary skill in the art would be motivated to combine the teachings of Singhal in view of "Official Notice" and Keeney because Keeney's system of polling would

Art Unit: 2154

increase security of Singhal's system by enabling a device (e.g. sub-computer) to poll the server (e.g. computer system) without the server to initiate contact to avoid the potential breach of firewall security in a local network environment (col. 6, lines 13-25).

41. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

42. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Lee whose telephone number is (571) 272-3967. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Philip Lee

 **JOHN FOLLANSBEE**
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100